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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,330	06/26/2003	Armand Malnoe	112701-365	4205
29157	7590	10/30/2006	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			MCCORMICK EWOLDT, SUSAN BETH	
			ART UNIT	PAPER NUMBER

1661

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/607,330

Applicant(s)

MALNOE ET AL.

Examiner

S. B. McCormick-Ewoldt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8,10,11,14,16,18 and 23-64 is/are pending in the application.
- 4a) Of the above claim(s) 23-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3,4,6,8,10,11,14,16,18 and 63-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

The amendment of September 20, 2006 is hereby acknowledged.

Applicant elected Group I and chicory in the Restriction Requirement dated February 8, 2005.

### **Claims Pending**

Claims 1, 3-4, 6, 8, 10-11, 14, 16, 18 and 23-64 are pending. Applicant has cancelled claims 2, 5, 7, 9, 12-13, 15, 17, 19-22. Claims 23-62 have been withdrawn from consideration. Claims 1, 3-4, 6, 8, 10-11, 14, 16, 18 and 63-64 will be examined.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

### **Written Description**

Claim 1 is drawn to plant material. In analyzing whether the written description requirement is met for genus claims, it is determined whether a representative number have been described. In this case, the one disclosed embodiment (i.e. chicory) is not representative of the *enormous* number of plant material claimed. The specification only provides plants of chicory. Therefore, Applicant is not in possession of the claimed plant material at the time this application was filed and lacks an adequate written description.

Claim 4 is drawn to the family *Asteracea* and the claimed chicory plant. In analyzing whether the written description requirement is met for genus claims, it is determined whether a

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representative number have been described. In this case, the one disclosed embodiment is not representative of the enormous number of plants claimed. *Asteracea* contains thousands of different plants species. The specification only provides plants of chicory. Therefore, Applicant is not in possession of the claimed plant at the time this application was filed and lacks an adequate written description.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Anantharaman *et al.* (US 5,952,033).

Anantharaman *et al.* (US 5,952,033) expressly teaches using a plant material extract (i.e. chicory) in a composition, which includes a starch source, a protein source and a fat source. The amount of chicory extract used is about 1% to about 5% by weight (col. 3, lines 23-66; col. 6, lines 42-43). Anantharaman also teaches the feed is fed into an extruder (col. lines 8-9). It is noted that in the Applicant's specification on page 3, line 22, that the term "thermally processed" also can mean "extruded." Therefore, Anantharaman meets the limitations of claim 1 as the composition comprises a thermally processed plant material containing chicory extract and a starch source, protein source and fat source where the amounts are from 1% to 5% and thus anticipates the claimed invention.

Applicant is requested to note that it is regarded that "intended use" of a composition will not further limit claims drawn to a composition. See, e.g., *Ex Parte Masham*, 2 USPQ2d 1647 (1987) and *In Re Hack* 114, USPQ 161. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of

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making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 8, 10-11, 14, 16, 18 and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermand (US 6,645,534 B2) in view of Anantharaman *et al.* (US 5,952,033) in view of Hwang *et al.* (US 5,905,089).

Hermand (US 6,645,534 B2) discloses that chicory is capable of pharmacological properties such as anti-inflammatory efficacies. In addition, Hermand teaches extracting chicory by hot extraction method (i.e. thermal) (col. 1, lines 21-27; col. 2, lines 38-41). Also, Hermand discloses that the plant material (i.e. chicory extract) comprises an amount of about 4.5% by weight (col. 6, lines 19-21).

Hermand does not teach wherein the composition further comprises a starch source, a protein source and a fat source.

Anantharaman *et al.* (US 5,952,033) disclose using a plant material extract (i.e. chicory) in a composition, which includes a starch source, a protein source and a fat source. The amount of chicory extract used is about 1% to about 5% by weight (col. 3, lines 23-66; col. 6, lines 42-43). Anantharaman also discloses the feed is fed into an extruder (i.e. thermally processed) (col. lines 8-9).

Hwang *et al.* (US 5,905,089) disclose that sesquiterpene lactones, obtained from plant material, possess an  $\alpha$ -methylene  $\gamma$ -lactone group which suppresses the expression of the inducible cyclooxygenase-2. In addition, Hwang discloses sesquiterpene lactones are useful in

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suppressing early proinflammatory cytokines and proteins, and in ameliorating severe inflammatory disorders (col. 4, lines 59-67; col. 5, lines 1-2, 45-50; col. 6, lines 15-18, 28)

One of ordinary skill in the art would have been motivated to use chicory extract to obtain sesquiterpene lactones along with a starch, a protein and a fat in a composition because of the known anti-inflammatory properties that chicory contains and the addition of starch, protein and fat would make the composition more palatable for ease of administration. It was clear from the Hermand reference that that chicory has anti-inflammatory properties and can be thermally extracted. It was further clear from the Anantharaman reference that a plant material extract (i.e. chicory) is used in a composition, which includes a starch source, a protein source and a fat source with the amount of chicory extract about 1% to about 5% by weight. It was further clear from the Hwang reference that sesquiterpene lactones, obtained from plant material, possess an  $\alpha$ -methylene  $\gamma$ -lactone group which suppresses the expression of the inducible cyclooxygenase-2 and sesquiterpene lactones are useful in suppressing early proinflammatory cytokines and proteins, and in ameliorating severe inflammatory disorders. Although none of the references disclose the specific active fragment of  $\alpha$ -methylene- $\gamma$ -butyrolactone, it would be inherent to the composition. Therefore, one of ordinary skill in the art would have had a reasonable expectation to use chicory in a composition because of the anti-inflammatory properties it contains.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

#### Summary

No claim is allowed.

#### Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme



CHRISTOPHER R. TATE  
PRIMARY EXAMINER